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BRUNSMA EXAMINER

A1M1/0724

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ART UNIT	PAPER NUMBER
1108	4

DATE MAILED: 07/24/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☒ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☒ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 16-21 are pending in the application.
   Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 16-21 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application apppears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

PTOL-326 (Rev. 2/93)

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 16-21 are rejected under 35 U.S.C. § 103 as being unpatentable over Foran et al.

The instant claims are in Jepson format, drawn to an improved cigarette wherein the improvement lies in the adhesive employed.

Table 1 component A of Foran et al teaches an adhesive comprising 70% water (30% solids), 6.5% gelatinized (modified) starch and 23% ungelatinized native corn (maize) starch. The similar starches employed would be expected to exhibit similar viscosities. The rheology modifier recited is optional. The difference between the prior art and the instant claims is the intended use of the adhesive. Foran et al teach an adhesive particularly for cardboard. It would have been obvious to one of ordinary skill in the art at the time of invention to employed the adhesive in cigarette manufacture because the material to be joined are similar

in composition, the conditions of application are similar and Foran et al specifically teach the adhesives are suitable for human consumption in packaging. See column 2. line 28-34.

The instant claims do not exclude the addition of an alkali by use of the open "includes" language. Evidence has been presented in the parent application of a viscosity difference and that the viscosity difference observed would destroy the intended utility recited. Amendment of the claims such that the adhesive recited corresponds to the allowed claims of the parent application would be persuasive of patentability.

In determining the relevant art one looks to the nature of the problem confronting the inventor. Weather Engineering Corp. of America v. United States, 204 USPQ 41, 46-47.

Having thus determined the scope and content of the prior art and the level of skill in the said art at the time the invention was made, it is the examiner's position that the claimed invention, as a whole, would have been obvious to one of ordinary skill in the art at the time the invention was made.

The mere failure of a reference to disclose all the advantages asserted by applicant is no a substitute for actual differences in properties. In re DeBlauwe, 222 USPQ 191. An apparently old composition cannot be converted into an unobvious one simply by the discovery of a characteristic one cannot glean form the cited prior art. Titanium Metals Corp. v. Banner, 227 USPQ 773.

Accordingly, the burden of proof is upon applicant to show that the instantly claimed subject matter is different form and unobvious over that taught by the prior art relied upon.

In re Brown, 173 USPQ 685, 689; In re Best, 195 USPQ 430; In re Marosi, 21 USPQ 289, 293.

Any evidence to be presented under 37 C.F.R. 1.131 or 1.132 should be submitted before final rejection in order to be considered timely. It is anticipated that the next office action will be a final rejection.

Any foreign language documents submitted by applicant have been considered to the extent the short explanation of significance, English abstract or English equivalent allow.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Brunsman whose telephone number is (703) 308-0662.

DMBrunsman

21 July 1995

David M. Brunsman
Primary Examiner
Group 1100